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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/834,950  | 04/16/2001  | Yoshihiko Yano       | 206138US0           | 5372             |
| 22850   | 7590        | 06/23/2004           | EXAMINER            |                  |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                      | THOMPSON, CAMIE S   |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1774                |                  |
| DATE MAILED: 06/23/2004   |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/834,950

Applicant(s)

YANO, YOSHIHIKO

Examiner

Camie S Thompson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,4-6,8-11 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-11 and 14-16 is/are allowed.
- 6) ☒ Claim(s) 1 and 5 is/are rejected.
- 7) ☐ Claim(s) 4, 6 and 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

### DETAILED ACTION

1. Applicant's amendment and accompanying remarks filed March 24, 2004 have been acknowledged.
2. The objection of claim 13 is withdrawn due to the cancellation of claim 13.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 56-057877.

The Japanese reference discloses a fluorescent body, which consists lanthanum thiogallate doped with cerium as per instant claims 1 and 5 (see abstract). The fluorescent material in the reference utilizes a different rare earth element for the matrix material than it does for the luminescent center as per instant claim 1. The fluorescent body consisting of the cerium activated lanthanum thiogallate of the Japanese reference emits light, as does the fluorescent thin film comprising a rare earth thiogallate with cerium luminescent center. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable in re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). The phrase "for an EL panel" is an intended use statement and thus is not given any patentable weight. The

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fluorescent body of the Japanese reference is capable of performing the intended use of light emission in an EL panel in re Schreiber, 128 F. 3d 1473, 1477, 44 USPQ 2d 1429, 1431 (Fe. Cir. 1997).

5. Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 56-082878.

The Japanese reference discloses a fluorescent body that consists of lanthanum thiogallate activated with cerium as per instant claims 1 and 5 (see abstract). The fluorescent material in the reference utilizes a different rare earth element for the matrix material than it does for the luminescent center as per instant claim 1. The fluorescent body consisting of the cerium activated lanthanum thiogallate of the Japanese reference emits light, as does the fluorescent thin film comprising a rare earth thiogallate with cerium luminescent center. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable in re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). The phrase "for an EL panel" is an intended use statement and thus is not given any patentable weight. The fluorescent body of the Japanese reference is capable of performing the intended use of light emission in an EL panel in re Schreiber, 128 F. 3d 1473, 1477, 44 USPQ 2d 1429, 1431 (Fe. Cir. 1997).

6. Claims 4, 6 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claims 9-11 and 14-16 are allowed. The prior art does not provide for a fluorescent thin film comprising a matrix material which comprises a rare earth sulfide or a rare earth selenide,

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and which further comprises a rare earth element as a light emission center, the rare earth element as the light transmission center being different from the rare earth element of the matrix material, and wherein said rare earth sulfide comprises at least one compound selected from the group consisting of lanthanum thioaluminate, neodymium thiogallate and yttrium thioindate.

### ***Response to Arguments***

8. Applicant's arguments filed March 24, 2004 have been fully considered but they are not persuasive. Applicant argues that the Japanese references do not suggest or teach the instant fluorescent thin film. The Japanese references both disclose a fluorescent material that emits light. A fluorescent thin film is a fluorescent body. The cerium activated lanthanum thiogallate of the Japanese references can be used for a thin film for light emission in an EL panel. Both Japanese references disclose a rare earth sulfide with a light transmission center that is different from the rare earth in the matrix material. The cerium activated lanthanum thiogallate fluorescent body of the Japanese references is not different from the fluorescent thin film of the instant application. Applicant argues that the light emission mechanism of the flying spot tube or an index tube is different from the light emission mechanism of the fluorescent thin film of the present invention. Both the Japanese references and the present invention claim a rare earth sulfide with a luminescent center that is different from the rare earth in the rare earth sulfide. Also, each reference and the present invention provide light emission. The manner in which the light emission is carried out is not given any patentable weight. The method in which the light emission is carried out does not make the rare earth thioaluminate with a different luminescent

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center of the rare earth of the thioaluminate matrix of the present invention a different product than that of the cerium activated lanthanum thiogallate fluorescent body of the Japanese references. Also, applicant argues that the process of film formation in the Japanese references is completely different from the film forming process of the present invention. The manner in which the film is formed does not make it a different product. The determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process. See MPEP 2113.

Applicant argues that the cerium activated lanthanum thiogallate of the Japanese references are used in a cathode ray tube instead of an El panel. In instant claim 1, the fluorescent thin film comprising a rare earth sulfide having a different rare earth from the rare earth of the sulfide matrix is claimed. The El panel is not claimed in instant claim 1. The intended use of a product does not determine its patentability. Instant claim 6, which recites an El panel comprising a fluorescent thin film comprising a matrix material, which comprises a rare earth sulfide with a rare earth luminescent center wherein the rare earth luminescent center is different from the rare earth of the sulfide matrix material, is now allowable subject matter. The rejection of instant claims 1 and 5 are maintained.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Camie S. Thompson whose telephone number is (571) 272-1530. The examiner can normally be reached on Monday through Friday from 7:30 am to 4:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia

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H. Kelly, can be reached at (571) 272-1526. The fax phone number for the Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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